

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1016710007P

Application Number
10/552,886

Filed
November 18, 2005

Art Unit
3734

Examiner
Eric D. Blatt

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Todd W. Wight/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Todd W. Wight

Typed or printed name

☒ attorney or agent of record.

Registration number 45,218

714 641-3460

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

February 27, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jurgen DORN

Application No.: 10/552,886

Confirmation No.: 4465

Filed: November 18, 2005

Art Unit: 3734

For: **LOADING AND DELIVERY OF SELF-
EXPANDING STENTS**

Examiner: E. Blatt

ARGUMENTS FOR PRE-APPEAL BRIEF PANEL REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits the following arguments in support of the Pre-Appeal Brief Request for Review filed concurrently herewith.

In a final Office Action mailed October 29, 2008 (hereinafter, "Office Action"), claims 1-19 and 21-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,607,551 to Sullivan et al. (hereinafter, "Sullivan"). Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sullivan in view of USPN 5,619,878 to Grosjean et al.

The primary issue for the Panel's consideration is whether Sullivan shows or describes the claimed features of: a stent covering material deformed by protrusions of a stent pusher that do not reach radially outwardly as far as the luminal envelope of a stent matrix (independent claims 1 and 3); protrusions of an inner catheter that extend into a stent covering without intersecting a plane along a luminal wall surface of the stent (independent claim 10); or a stent covering layer deformed by protrusions of a stent pusher that do not intersect a plane along a luminal wall surface of the stent (independent 19).

Applicant has argued that, differently from the claimed invention, Sullivan shows and describes a stabilizer with protrusions that contact members of the stent framework, as opposed to deforming a covering material or layer. Support for this position was provided by Applicant through citation of passages in Sullivan, which can be found in Applicant's Response filed July 1, 2008, but are not reproduced herein. Applicant further noted that even assuming *arguendo* that Sullivan did disclose a stent with a covering deformed by protrusions of a pusher or inner catheter, there is no hint or suggestion that the protrusions deform the covering without extending into the luminal envelope of the stent matrix or without intersecting a plane along the luminal wall surface.

In the Response to Arguments section of the Office Action, the Examiner states that "[i]n order for the protrusions to directly engage the stent framework, the protrusions would have to be sized and shaped to extend entirely through the inner covering layer." (Office Action, p. 7). The conclusion from this proposition is that, because Sullivan teaches a mere frictional engagement, the protrusions would not need to extend through the inner covering layer. Instead, it is proposed by the Examiner that one of ordinary skill in the art would have found it obvious to crimp a covered stent onto the Sullivan stabilizer "with sufficient force to create a frictional engagement therebetween without extending the protrusions entirely through the inner covering layer in order to prevent damage to the stent." (Office Action, p. 8). With respect to the limitation on the extension of the protrusions, the Examiner alleges that the teaching of frictional engagement (*see* col. 6, ll. 3-5) would lead one of ordinary skill in the art to limit the extension of the protrusions into the covering layer. (Office Action, p. 3).

Initially, Applicant requests Panel review of whether the sentence, "[a]s used herein, however, the term 'stent' is a shorthand reference referring to a covered or uncovered such stent" (Sullivan, col. 1, ll. 25-27) in view of the remainder of the Sullivan disclosure is sufficient to teach extension of protrusions into a stent covering layer or deformation of a stent covering layer by protrusions, as claimed. As set forth in Applicant's Response filed July 1, 2008, Sullivan does not discuss a stent covering layer anywhere else in the disclosure, and all examples and embodiments describe engagement or frictional contact between the stabilizer and the stent. Thus, rather than disclosing protrusions extending into a covering layer, Sullivan appears to *teach away* from such a

configuration. The Examiner even admits that “it appears that the disclosure of Sullivan is primarily concerned with combining the delivery system [and] an uncovered stent” (Office Action, p. 7). However, despite this, the Examiner maintains that a stent covering material deformed by protrusions would be obvious to one of ordinary skill in the art in view of Sullivan. Applicant disagrees with this position and submits that each of independent claims 1, 3, 10, 19, and 28 are patentable over Sullivan for at least this reason.

However, assuming *arguendo* that Sullivan does, in fact, establish a *prima facie* case of obviousness with respect to the feature of a stent covering deformed by protrusions of a pusher or inner catheter, the primary issue set forth above must still be resolved. That is, whether Sullivan teaches protrusions that deform or extend into the stent covering *without extending into the luminal envelope of the stent matrix* or *without intersecting a plane along the luminal wall surface*. Applicant submits that neither of the Sullivan embodiments (i.e., penetration into open spaces between stent elements and frictional engagement with the inner periphery) teaches or suggests these claimed features.

The luminal envelope of the stent matrix is defined in the Instant Application (p. 7 of the published WO document and paragraph [0028] of the published US document) as follows (underlining added for emphasis):

...we use the terminology ‘envelope’ to indicate the generalised surfaces of the luminal and abluminal major wall surfaces of the stent body. Thus, the outer layer 22 lies outside the abluminal envelope stent body 20. . . and, likewise, the inner layer lies radially within the luminal envelope of the stent body. . .”

With respect to the embodiment of penetration into open spaces between stent elements, it is clear that the Sullivan stabilizer extends through the luminal envelope and intersects a plane along the luminal wall surface, and therefore teaches away from the claimed features.

With respect to the embodiment of frictional engagement with the inner periphery, the Sullivan frictional engagement itself consists of extending into the luminal envelope of the stent matrix and intersecting a plane along the luminal wall surface. This is because the term “luminal envelope” as defined by the Instant Application includes the luminal stent surface. Thus, *any* frictional engagement of the stent by the Sullivan protuberances necessarily means that the protrusions extend into the luminal envelope and intersect a plane along the luminal wall surface.

Accordingly, in view of the above, Sullivan does not establish a *prima facie* case of obviousness at least because Sullivan does not teach or suggest all of the limitations of the independent claims. Therefore, Applicant submits that claims 1-19 and 21-32 are patentable over Sullivan.

Regarding dependent claim 20, Applicant submits that the asserted combination is insufficient to establish a *prima facie* case of obviousness in view of the above.

In conclusion, Applicant respectfully requests review of the rejections under 35 U.S.C. § 103 in view of Sullivan, and solicits a Notice of Allowance in due course. In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-2191 referencing docket no. 1016710007P. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: February 27, 2009

Respectfully submitted,

Electronic signature: /Todd W. Wight/
Todd W. Wight

Registration No.: 45,218
RUTAN & TUCKER
611 Anton Blvd, Suite 1400
Costa Mesa, California 92626
(714) 641-3460
patents@rutan.com